

REMARKS

I. Status of Claims

Currently, claims 1-3, 7-14, 23-25, and 57-59 are pending in this application. The Office has indicated that claims 1-3, 7-14, and 23-25 are allowed. Office Action at 1.

Applicant has amended claim 57 to recite “wherein the encoded amino acid sequence binds to and stabilizes single stranded DNA.” Support for this amendment can be found throughout the specification, including for example at page 5, lines 12-13, page 60, and Figure 18. The amendment to the claim 57 does not introduce any subject matter that was not already inherently covered by the claim, and thus does not alter the scope or content of the claimed subject matter. Accordingly, no new matter is added by this Amendment.

II. Rejections Under 35 U.S.C. § 112, First Paragraph

A. The Specification Provides Written Description Support for Claims 57-59

The Office maintains the rejection of claims 57-59 under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter that is not described in the specification so as to reasonably convey to the person skilled in the art that Applicant was in possession of the claimed invention at the time the application was filed. Office Action at 2.

Previously, Applicant amended claim 57 to recite that “the encoded amino acid sequence [having 95% identity to SEQ ID NO:66] binds to single stranded DNA.” Applicant submits that the claimed subject matter recites relevant, identifying characteristics that satisfy the written description requirement. The Office, however, maintains the written description rejection,

asserting that “Applicant’s amendment requiring that the ‘encoded amino acid sequence bind to single stranded DNA’ is not considered a sufficiently specific function that applicants have adequately described a structure to function relationship for the claimed genus. The mere binding to single stranded DNA is insufficient to suffice for a functional limitation of the claimed genus.” Office Action at 3. Applicant submits that in the context of claim 57, the binding of a polypeptide to a substrate, such as single stranded DNA, adequately describes a structure to function relationship for the claimed genus.

The Office further notes that “Applicant’s attention is directed to applicant’s specification in which applicants state “(RFA) that bind and stabilize the resulting single-stranded DNA template.” *Id.* Applicant thanks the Examiner for this suggestion.

Although Applicant respectfully disagrees with the rejection, in an effort to expedite prosecution, claim 57 has been amended to recite “a polynucleotide encoding an amino acid sequence possessing 95% identity to SEQ ID NO:66, wherein the encoded amino acid sequence binds to and stabilizes single stranded DNA.” Accordingly, Applicant respectfully requests that the Office withdraws this written description rejection of claims 57-59.

B. The Specification Enables Claims 57-59

The Office also maintains the rejection of claims 57-59 under 35 U.S.C. § 112, first paragraph, as allegedly failing to enable a person skilled in the art to make and use the invention commensurate in scope with the claimed invention. Office Action at 4.

As noted above, Applicant previously amended claim 57 to recite that “the encoded

amino acid sequence [having 95% identity to SEQ ID NO:66] binds to single stranded DNA.” In response, the Office asserts that the “mere binding to single stranded DNA is insufficient to suffice for a functional limitation of the claimed genus.” *Id.* at 5. Applicant submits that it would not require undue experimentation for one of skill in the art to make and use a polynucleotide encoding an amino acid sequence possessing 95% identity to SEQ ID NO: 66, where the encoded amino acid sequence binds to single stranded DNA. Given Applicant’s disclosure and the available, routine screening methods for detecting the binding of polypeptides to single stranded DNA, the experimentation involved to make and use additional polynucleotides falling within the scope of the claims, and thus practice the full scope of the pending claims, would have been routine and well within the skill of those in the art. *See e.g., Johns Hopkins Univ. v. Cellpro, Inc.*, 152 F.3d 1342, 1360, 47 USPQ2d 1705, 1719 (Fed. Cir. 1999 (“test [for undue experimentation] is not merely quantitative . . . if it is merely routine.”)).

However, as noted above, claim 57 has been amended to recite that the “the encoded amino acid sequence binds to and stabilizes single stranded DNA.” This amendment renders the enablement rejection moot and, therefore, Applicant respectfully requests that the Office withdraw this rejection.

III. Conclusion

Applicant believes that all of the substantive issues raised in the Office Action dated 4 December 2007 have been addressed, and all objections and rejections overcome. Accordingly, Applicant believes that this application is in condition for allowance. If the Office believes anything further is required in order to place this application in even better condition for allowance, Applicant requests that its undersigned representative be contacted at the number listed below to discuss remaining issues.

Please grant any extensions of time required to enter this paper and charge any additional required fees to Deposit Account No. 50-3740.

Respectfully submitted,
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